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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,226	01/09/2001	Isamu Ooishi	1095.1149 (JDH)	6990

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EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 04/07/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/756,226

Applicant(s)

OOISHI, ISAMU

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date #2- 01/09/2001.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to application filed **01/09/2001**. This application is a **CON of PCT/JP98/05927** filed **12/24/1998**. Also claim for foreign priority **JAPAN 10-238128** filed **08/25/1998**.
2. Claims 1-13 are currently pending in this application. Claims 1, 9 and 13 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As to independent claim 9, the claimed invention is not tied to the technological art environment or machine, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claimed invention is not embodied on a computer readable medium, nor are the "executable instructions" explicitly recited as being carried out, or functionally tied in, to a computer environment (i.e. compilation means for compiling an output document is not producing a concrete, useful, and

tangible result to form the basis of statutory subject matter under 35 U.S.C. 101).
Therefore, the claims read on steps that could be carried out mentally and/or using paper and pencil.

As to dependent claims 10-12 also are not tied to the technological art environment or machine, and are rejected under the same rationale.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-8, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated over Ooishi US Patent No. 5,890,184 issued 03/30/1999 filed 10/10/1996 (hereinafter '184).**

In regard to independent claim 1, "(a) a special character image management unit comprising: special character definition means for creating a special character database file that defines which characters to convert into graphic images, special character image generation means for producing graphical images of the special characters that said definition means has determined as being relevant to the conversion, with reference to a given character pattern dictionary containing character pattern data" is taught in '184 col. 2, lines 50-67, "**first image data storage means for**

Art Unit: 2176

storing the special character database file produced by said special character definition means and the special character images produced by said special character image generating means" is taught in '184 col. 2, lines 55-67 (i.e. ...character management file storing means for storing...), "*and uploading means for transmitting the special character database file and the special character image files*" is taught in '184 col. 2, lines 55-67 (i.e. ... external character fetching means for fetching...), "*(b) a document conversion unit comprising: second image data storage means for storing the special character database file and special character images received from said uploading means*" is taught in '184 col. 3, lines 10-18 (i.e. ... transformation process is executed by the external character transforming means, and external character editing means for editing an external character recorded in the external character management file storing means), "*special character identification means for identifying a special character used in a given source document by consulting the special character database file stored in said second image data storage means*" is taught in '184 col. 2, lines 65-67 (i.e. ... associated with the external character recording ...), "*link generation means for producing a link to one of the special character image files that is relevant to the identified special character*" is taught in '184 col. 4, lines 39-50 (i.e. When external characters are fetched from an external character management file to the distributee's external character file ... checked against that of the distributee's external character file), "*compilation means for compiling an output document by replacing the special character identified in the source document with the link to the corresponding special*

character image file” is taught in ‘184 col. 5, lines 55-59 (i.e. ... operating system are called and executed as needed).

In regard to dependent claim 2, *“special character definition means defines character codes and character sizes of the special characters to be converted”* is taught in ‘184 col. 7, lines 30-40 (i.e. ... conversion of external character codes to JEF code by means of the code conversion functions... size and data format...).

In regard to dependent claim 3, *“special character image generation means produces one special character image file for each identified special character, based on the character pattern data read out of the given character pattern dictionary”* is taught in ‘184 col. 7, lines 41-46 (i.e. ... an external character management file as a source of transformation is read by means of the file access functions 24, and conversion to a target data format is performed by means of the data format conversion functions 26...).

In regard to dependent claim 4, *“special character image generation means produces as many special character image files as the number of different character sizes for each identified special character, based on the character pattern data read out of the given character pattern dictionary”* is taught in ‘184 col. 6, lines 65-67 (i.e. ... external character management file group 23 is made up of multiple... files).

In regard to dependent claim 5, *“assigns a file name to each produced special character image file, the file name comprising text fields that indicate the character code and the character size, whereby an appropriate special character image file can be*

uniquely and immediately identified by a given character code and character size" is taught in '184 col. 8, lines 20-30.

In regard to dependent claim 6, *"font size tracking means for finding character size attribute information in the given source document and maintains the extracted information locally"* is taught in '184 col.3, lines 1-19 (i.e. ... data format or size of the external character when transformation process is executed by the external character transforming means, and external character editing means for editing an external character recorded in the external character management file storing means).

In regard to dependent claim 7, incorporate substantially similar subject matter as cited in claims 1 and 6 above, and is similarly rejected along the same rationale.

In regard to dependent claim 8, *"code conversion means for converting a character code used in the given source document into another character code belonging to a required coding system, when the character code is identified as a non-special character by said special character identification means"* is taught in '184 col.3, lines 1-5.

In regard to independent claim 13, is directed to a computer readable medium for performing the method of claim 1, and is similarly rejected under the same rationale.

7. **Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated over Kawabata et al. US Patent No. 5,600,770 issued 02/04/1997 filed 06/05/1995 (hereinafter '770).**

In regard to independent claim 9, “a special character image dictionary which is a collection of special character image files each containing a graphic image of a special character” is taught in ‘770 col. 4, lines 54-55 (i.e. the font server 101 stores letter data in a plurality of font files), “a special character database file which contains data to manage the special character image files in said special character image dictionary” is taught in ‘770 col. 4, lines 6-10 (i.e. the document processing system in which a font server (letter data controller)), “special character identification means for identifying a special character used in the created document, by consulting the special character database file” is taught in ‘770 col. 4, lines 20-37 (i.e. ...edit documents...), “link generation means for producing a link to one of the special character image files that is relevant to the identified special character” is taught in ‘770 col. 4, lines 20-37 (i.e. transmits the request letter data or data in which the requested data has been converted, to the work station 102 through the communication circuit 106), “compilation means for compiling an output document by replacing the special characters identified in the source document with the links to the special character images” is taught in ‘770 col. 3, lines 30-35 (i.e. ... suitable programming of a standard computer connected to a letter data storage device ...).

In regard to dependent claim 10, “*font size tracking means for extracting character size attribute information from the created document and keeps the extracted information locally*” is taught in ‘770 col. 4, lines 25-37 (i.e. store that letter data in the font cache in case that letter data is needed again).

In regard to dependent claim 11, *"link generation means produces a link to one of the special character image files that meets the special character code identified by said special character identification means and the character size attribute information maintained in said font size tracking means"* is taught in '770 col. 4, lines 20-37 (i.e. transmits the request letter data or data in which the requested data has been converted, to the work station 102 through the communication circuit 106).

In regard to dependent claim 12, *"code conversion means for converting a character code used in the created document into another character code belonging to a required coding system, when the character code is identified as a non-special character by said special character identification means"* is taught in '770 col. 3, lines 7-18 (i.e. convert the fonts to a vector font, e.g.... only when needed...).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ando	U.S. Patent No. 5,321,801	issued 06/14/1994	filed 08/05/1993
Murakami	U.S. Patent No. 5,479,167	issued 12/26/1995	filed 08/31/1994
Zhong	U.S. Patent No. 5,617,314	issued 04/01/1997	filed 09/12/1994
Oyamada et al.	U.S. Patent No. 5,659,772	issued 08/19/1997	filed 01/25/1995

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-

Art Unit: 2176

8781. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran

Patent Examiner

Technology Center 2176

March 30, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER